

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERRY WARREN

Application No. 09/632,318

ORDER RETURNING TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on February 11, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith returned to the examiner. The matters requiring attention prior to docketing are identified below.

Appellants filed an Appeal Brief on October 4, 2003 (Paper No. 20). On page 3 of the Examiner's Answer mailed November 14, 2003 (Paper No. 21), the examiner improperly

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refers to two previous Office actions (Paper Nos. 8 and 18).
Section 1208(A) of the Manual of Patent Examining Procedure
(MPEP) (8th Ed., Rev. 1, Feb. 2003) states:

Examiners may incorporate in the answer their statement of the grounds of rejection merely by reference to the final rejection (or a single other action on which it is based, MPEP § 706.07). Only those statements of grounds of rejection appearing in a single prior action may be incorporated by reference. An examiner's answer should not refer, either directly or indirectly, to more than one prior Office action.

Furthermore, MPEP § 706.07 states:

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

Compliance with MPEP § 1208 is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner for compliance with MPEP § 1208 regarding the grounds of rejection appearing in the Examiner's Answer mailed

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November 14, 2003 (Paper No. 21), and for such further action
as may be appropriate.

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